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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 07/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/996,565

Applicant(s)

VAYRETTE, SOPHIE HELENE

Examiner

Christopher P Bruenjes

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1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 29-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28, 39 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-28 and 39-40, drawn to a box, classified in class 428, subclass 36.1.

II. Claims 29-38, drawn to a method of making a box, classified in class 156.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another process such as applying an adhesive to a non-woven material and then placing the adhesive covered non-woven material onto the support blank, before folding the support into a box.

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2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Chris Kent on June 23, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-28 and 39-40. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29-38 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 6-7, 15, 18, 22-23, 28, and 39-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Chono et al (JP 08-050452).

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Chono et al anticipate a box comprising a body formed from a blank that is precut with score lines and folded to form the body (p.4, paragraph 25 of machine translation and Fig. 5). The blank comprises a support having a first surface and a second surface, wherein the outer surface has printing thereon, and at least one sheet of non-woven material arranged on the outer surface by adhesive, in which the non-woven material is partially transparent so that the printing on the support is visible through the non-woven material (see abstract). The non-woven material is formed from thermoplastic fibers, such as polyester (see abstract).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 4-5 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chono et al (JP 08-050452).

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Chono et al teach all that is claimed in claims 1 and 23 as shown above, but fail to teach adding a second layer exactly like the first layer of printing and non-woven material arranged by adhesive bonding to the outer surface of the box, also to the inner surface of the box, in order to provide aesthetic appeal to the inner surface as well as the outer surface. One of ordinary skill in the art would have recognized that for the same reasons printing and a non-woven material are attached to the outer surface of the box, printing and a non-woven material would be added to in the inner surface of the box, especially for aesthetic appeal.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to add printing and a non-woven material to the inner surface of the box, that performs the same purpose as the printing and non-woven material on the outer surface of the box, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

6. Claims 8-14 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chono et al (JP 08-050452) in view of Ovadia et al (USPN 4,767,000).

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Chono et al teach all that is claimed in claims 1 and 23 as shown above, but fail to explicitly teach the composition of the support layer. However, Ovadia et al teach that boxes made from blanks that are covered with a non-woven material, such as felt, is well known to be made from a thin cardboard or thermoplastic material (col.6, 1.33-41). One of ordinary skill in the art would have recognized that the specific grammage of the cardboard material or the specific thermoplastic material is chosen depending on the intended end result of the box after routine experimentation.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the composition of the support layer from either cardboard or thermoplastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Additionally, Ovadia et al explicitly teach that the support layer is thin, but neither Ovadia et al nor Chono et al explicitly teach the specific claimed thickness of the support layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the support layer with a thickness between 300 and 600 micrometers,

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since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art, absent the showing of unexpected result. *In re Boesch*, 205 USPQ 215 (CCPA 1980).

7. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chono et al (JP 08-050452).

Chono et al teach all that is claimed in claim 1, but fails to explicitly teach the thickness of the sheet of non-woven material. However, one of ordinary skill in the art would have recognized that depending on the intended end result of the box the thickness of the non-woven material would be determined through routine experimentation.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the sheet of non-woven material with a thickness between 100 and 200 micrometers, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art, absent the showing of unexpected result. *In re Boesch*, 205 USPQ 215 (CCPA 1980).



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8. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chono et al (JP 08-050452).

Chono et al teach all that is claimed in 15 as show above and teach that the non-woven material is formed from a thermoplastic fiber such as polyester (see abstract). Chono et al fail to explicitly teach using polypropylene or polyethylene fibers as the thermoplastic fibers for the non-woven material. One of ordinary skill in the art would have recognized that polyester, polypropylene, and polyethylene fibers are all well known interchangeable fibers for forming sheets of non-woven material.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute polypropylene or polyethylene fibers for polyester fibers, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

#### **Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 703-305-3440.

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The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB

July 2, 2003



WILLIAM P. WATKINS III  
PRIMARY EXAMINER